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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/308,770	10/28/1999	FRITZ SCHWERTFEGER	3259.81131	6628

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EXAMINER

JOLLEY, KIRSTEN

ART UNIT PAPER NUMBER

1762

DATE MAILED: 10/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/308,770

Applicant(s)

SCHWERTFEGER, FRITZ

Examiner

Kirsten C. Jolley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments/Amendments

1. The claim objection and 35 USC 112, 2nd paragraph rejections have been withdrawn in response to Applicant's amendments and arguments.
2. Applicant's arguments filed July 31, 2006 regarding the 35 USC 103(a) rejections have been fully considered but they are not persuasive.

With respect to the rejections over WO '942 taken in view of Lentz and over WO '809 taken in view of Lentz and WO '942, Applicant argues that Lentz' invention is the combination of an essential acid-heating step and a hydrophobing step, and therefore Lentz cannot be cited for its teaching of specific organosilicon compounds alone as stated by the Examiner. Applicant states that one skilled in the art would only use the specified surface-silylating substances for the hydrophobing step in combination with the acid-heating step, and to do otherwise would go against the expressed teaching of the reference. The Examiner disagrees. While it is acknowledged that Lentz' process involves a two-step process, the fact that Lentz' process is a two-step process does not preclude the reference from being a valid teaching as to known surface-silylating agents for hydrophobing organogels. The organosilicon compounds in Lentz are used for the same purpose, the compounds react according to the same reaction, and are similarly for use in forming aerogels as in WO '942 and WO '809. There is nothing in Lentz that discloses or even suggests that the surface-silylating agents of its invention are only successful in combination with a first acid-heating step. The first acid-heating step of Lentz is merely the means for producing the organogel, prior to the hydrophobing step, of its particular

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product. Therefore it is the Examiner's position that one skilled in the art would *not* conclude that the acid-heating step of Lentz need be incorporated into the teachings of WO '942 or WO '809 in order to make use of the hydrophobing teachings, as argued by Applicant.

Examiner Suggestions

3. Due to the restructuring of claims during prosecution, the following typographical errors are noted:

In claims 8-10, it appears that "step c)" should be --step b)-- because washing occurs in step b).

In claims 11 and 13-16, it appears that "step d)" should be --step c)-- because surface-silylating occurs in step c).

In claim 17, it appears that "step e)" should be --step d)-- because there is no step e).

In claim 21, it appears that "step c)" should be --step b)-- because the organic solvent is used for washing in step b).

In claim 24, it appears that "step d)" should be --step c)--.

In claim 9, it appears that the symbol " \leq " is missing in line 2.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 6-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 19, line 4, the claim is vague and indefinite because the symbol indicating the relationship of the pH value to 3 is missing. For the purpose of examination, the symbol is assumed to be " \leq " because that is what is disclosed in the specification.

In claim 20, line 2, the claim is vague and indefinite because the symbol indicating the relationship of the pH value to 3 is missing. For the purpose of examination, the symbol is assumed to be " \leq " because that is what is disclosed in the specification.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6 and 8-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/22942 A1 in view of Lentz (US 3,122,520).

Schwertfeger et al. (US 5,888,425) is used as a working English translation of WO 96/22942 A1.

The claim rejections are maintained for the same reasons set forth in the prior Office action and discussed above in section 2. As to the newly added limitation in claim 19, it is noted that Schwertfeger et al. discloses the claimed step in column 3, lines 10-15.

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/22942 in view of Lentz et al. as applied to claims 6 and 8-24 above, and further in view of WO 96/06809.

Frank et al. (US 5,866,027) is used as a working English translation of WO 96/06809.

The claim rejection is maintained for the same reasons set forth in the prior Office action and discussed above in section 2.

9. Claims 6-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/06809 A1 in view of Lentz (US 3,122,520) and WO 96/22942 A1.

Frank et al. (US 5,866,027) is used as a working English translation of WO 96/06809 A1, and Schwertfeger et al. (US 5,888,425) is used as a working English translation of WO 96/22942 A1.

The claim rejections are maintained for the same reasons set forth in the prior Office action and discussed above in section 2. As to the newly added limitation in claim 19, it is noted that Frank et al. discloses the claimed step in column 4, lines 32-40.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

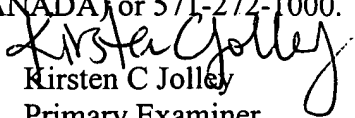
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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten C. Jolley whose telephone number is 571-272-1421. The examiner can normally be reached on Monday to Wednesday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Kirsten C Jolley
Primary Examiner
Art Unit 1762

kcj